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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,215	10/22/2003	Nancy B.M. Stefanuk	11240.00	8271
26889	7590	05/22/2009		
MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001			EXAMINER CHU, RANDOLPH I	
			ART UNIT	PAPER NUMBER
			2624	
			MAIL DATE	DELIVERY MODE
			05/22/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/691,215

**Applicant(s)**

STEFANUK, NANCY B.M.

**Examiner**

RANDOLPH CHU

**Art Unit**

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/85/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 12/18/2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Brian P. Werner/

Supervisory Patent Examiner, Art Unit 2624

***Response to Argument***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Applicant's arguments with respect to claims 1, 2, 11 and 14 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 11 and 14 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example the method including steps of storing, receiving, comparing and providing is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,432,506 to Chapman.

With respect to claim 1, Chapman teaches, sheet material having a first area portion (Fig. 1, ref. label 10, Check number field), and a second area portion (Fig. 1, ref. label 18, unique code) which is different from the first area portion;

means defining at least one symbol which is pre-printed on the first area portion of the sheet material (Fig. 1, ref. label 10, Check number field); and

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means for storing on the second area portion of the sheet material encoded information including apriori reference image quality data (Fig. 1, ref. label 18, unique code) which is representative of at least one image quality, characteristic of associated with the at least one symbol which is pre-printed on the first area portion of the sheet material (col. 3 line 40 – col. 5 line 3).

With respect to claim 2, Chapman teaches, sheet material having a first area portion (Fig. 1, ref. label 10, Check number field) and a second area portion (Fig. 1, ref. label 18, unique code) which is different from the first area portion;

at least one symbol which is other than a magnetic ink character recognition (MICR) code line and which is pre-printed on the first area portion of the sheet material (Fig. 1, ref. label 10, Check number field); and

means for storing on the second area portion of the sheet material encoded information including apriori reference image quality data (Fig. 1, ref. label 18, unique code) which is representative of at least one image quality characteristic of associated with the at least one symbol which is other than a MICR code line and which is pre-printed on the first area portion of the sheet material col. 3 line 40 – col. 5 line 3).

With respect to claim 11, Chapman teaches, storing on the second area portion of the financial document encoded information including apriori reference image quality data (Fig. 1, ref. label 18, unique code) which is representative of an image quality characteristic of associated with at least one symbol which is pre-printed on the first

area portion (col. 3 line 40 – col. 5 line 3, representative of check number field) of the financial document;

receiving image data which is representative of the image of the financial document (Fig. 2, ref . label 22);

retrieving the stored apriori reference image quality data from the encoded information stored on the second area portion of the financial document (Fig. 2, ref . label 23);

comparing the retrieved apriori reference image quality data with the received image data to determine the image quality of the symbol which is pre-printed on the first area portion of the financial document (Fig. 2, ref . label 24); and

providing an indication of quality of the image of the financial document based upon the comparison of the retrieved apriori reference image quality data with the received image data (Fig. 2, ref . label 25, accept or reject).

With respect to claim 14, Chapman teaches, storing on the second area portion of the check encoded information including apriori reference image quality data (Fig. 1, ref. label 18, unique code) which is representative of an image quality characteristic associated with a symbol which is other than a magnetic ink character recognition (MICR) code line and which is pre-printed on the first area portion of the check (col. 3 line 40 – col. 5 line 3, representative of check number field);

receiving image data which is representative of the image of the check (Fig. 2, ref . label 22);

retrieving the apriori reference image quality data from the encoded information stored on the second area portion of the financial document (Fig. 2, ref . label 23);

comparing the retrieved apriori reference image quality data with the received image data to determine the image quality of the symbol which is other than a MICR code line and which is pre-printed on the first area portion of the check (Fig. 2, ref . label 24); and

providing an indication of quality of the image of the check based upon the comparison of the retrieved apriori reference image quality data with the received image data (Fig. 2, ref . label 25, accept or reject).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randolph Chu whose telephone number is 571-270-1145. The examiner can normally be reached on Monday to Thursday from 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Werner can be reached on 571-272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status



information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RIC/

/Brian P. Werner/  
Supervisory Patent Examiner, Art Unit 2624